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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/995,652	11/29/2001	Akitoshi Kojima	1247-0464P	2631

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FALLS CHURCH, VA 22040-0747

EXAMINER
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ARAQUE JR, GERARDO

ART UNIT	PAPER NUMBER
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3629

NOTIFICATION DATE	DELIVERY MODE
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05/11/2007

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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mailroom@bskb.com

<b>Office Action Summary</b>	<b>Application No.</b> 09/995,652	<b>Applicant(s)</b> KOJIMA ET AL.	
	<b>Examiner</b> Gerardo Araque Jr.	<b>Art Unit</b> 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claim 14** is rejected under 35 U.S.C. 102(b) as being anticipated by Murrah et al (US Patent 5,804,807).

3. In regards to **claim 14**, Murrah discloses, "... a portable data collecting terminal 50 (the "terminal") includes a bar code scanner 51, a printer 55, a magnetic card reader 56, a display 57, a keypad 58 and a communication interface port 58A. The scanner 51 is coupled to a data processor and storage device which is connected to an RF transmitter 53, which is further couple to an RF antenna (Column 5 Lines 32 – 38)." (See also discussion below).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1 – 13** are rejected under 35 U.S.C. 103(a) as being unpatentable over of Murrah et al (US Patent 5,804,807) in view Roach et al. (US Patent 5,310,997) and in further view of Garber et al (US Patent 6,232,870).

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6. In regards to **claims 1 and 3**, Murrah discloses a portable terminal that is provided, which reads a tag on a commodity (Column 4 Line 21 – 23), stores the information (Column 2 Lines 24 – 28), and displays the information on a display that is found on the portable terminal (Column 2 Lines 20 – 35). Moreover, Murrah also discloses that data collection systems, such as the portable terminals disclosed by Murrah, are not only reserved to be used by the roving attendants, but by any other potential user, such as customers (Column 3 Lines 4 – 7). It would have been obvious to lend customers to use the portable terminals if enough portable terminals are provided and, of course, have them return the portable terminals when they have finished shopping.

When the customer is ready to checkout they will have their commodities ready for them at the exit counter with some type of pre-marked coding to match the commodity with the customer (Column 5 Lines 23 – 27). Moreover, all of the information that is being gathered by the portable terminal is being relayed to the central processing unit of the wireless network that is being incorporated (Column 3 Lines 29 – 35). Murrah further discloses comparing at the information-processing apparatus the commodity information which has already been relayed to the information-processing apparatus, with the commodity information which is sent from the portable terminal to a POS apparatus at a sales counter and is then entered into the information-processing apparatus (Column 5 Lines 62 – 67; Column 6 Lines 18 – 32; wherein it is obvious for the information-processing apparatus to compare the two sets of data in order to

properly inventory the items of the store and to make sure that all information stored within the system's database and what is scanned are the same).

However, Murrah fails to teach the commodity being displayed in a display area, having the RFID tags being written to, and handing the commodities to the customer after the purchases have been made.

Roach does disclose that it is old and well known that systems incorporating the invention as disclosed by Murrah use a method of displaying a commodity in a retail area and having the customer pick up the item after purchases have been made (Roach Column 1 Lines 20 – 25). This method is especially useful when it comes to saving space on a retail floor. Moreover, it would be obvious to incorporate the RFID tag, as disclosed by Murrah (Column 7 Lines 63 – 67), onto the sample commodities. Furthermore, Roach discloses that once the commodity has been selected for purchase, the information would then be forwarded to the warehouse and the commodity is prepared to be picked up by the customer (Column 10 Lines 13 – 30).

However, the combination of Murrah and Roach fails to disclose that the RFID tags can be written to.

Garber teaches that those well known in the art know that RFID tags can be modified to have a wide selection of uses, such as having them being rewritable in order for them to be used multiple times (Column 5 Lines 47 – 50 and Column 7 Lines 17 – 34).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention in view of the teaching of Roach to modify Murrah to have

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sample commodity with the corresponding RFID tag on a display floor. Moreover, it would have been obvious to one having ordinary skill in the art at the time of the invention in view of the teaching of Garber to allow the portable terminal to include a rewriting mechanism to the portable terminal used in the combination of Murrah and Roach so that the RFID tags can be rewritten with new commodity information in order to reuse the tags and avoid purchasing new tags when replacing old commodities with new commodities or for a price change.

7. In regards to **claim 2**, Murrah in combination with Garber, as was previously discussed above, disclose that the information on the wireless tag is read and written by a portable terminal and that the information is then relayed to a central processing unit over a radio communication link (Column 3 Lines 55 – 63). Moreover, Murrah teaches that other coding schemes can be used, such as radio frequency identification tags, which are well known in the art to be capable of being written onto wirelessly (Column 7 Lines 63 – 67).

8. In regards to **claim 4**, Murrah is discussed above, but fails to teach a rewriting apparatus for rewriting commodity information on a wireless tag as being part of the system architecture.

Garber teaches that those well known in the art know that RFID tags can be modified to have a wide selection of uses, such as having them being rewritable in order for them to be used multiple times (Column 5 Lines 47 – 50 and Column 7 Lines 17 – 34).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention in view of the teaching of Garber to modify Murrah and have RFID tags that can be rewritten with new commodity information in order to reuse the tags and avoid purchasing new tags when replacing old commodities with new commodities or for a price change. This would inherently require a rewriting apparatus or a rewriting feature to be attached to the portable terminal.

9. In regards to **claims 5 – 6**, Murrah discloses that the user, "...tallies the total on the portable data collecting terminal...(Column 4 Lines 44 – 45)"

10. In regards to **claim 7**, Murrah discloses a portable terminal with a scanner coupled with a data processor and storage device (Column 5 Lines 35 - 36) with a printer and display in order to present the customer with commodity information (Column 5 Lines 32-35).

11. In regards to **claim 8**, Murrah discloses a portable scanner that scans the commodity information and relays it to a central processing unit because of its constant communication over a radio communication link (Column 7 Lines 40 – 46).

12. In regards to **claim 9**, Murrah discloses a central processing unit that is connected to a portable terminal through a radio communication link on a local area network that is capable of storing and creating a customer purchase record (Column 4 Lines 21 – 30).

13. In regards to **claims 10 – 13** Murrah discloses that the central process system is connected to the portable terminal wirelessly and has a display so that the customer is able to view their selection. The customer then approves of the selected commodities

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during the checkout process, but if the customer wants to correct the displayed selection then the attendant is able to do so (Column 6 Lines 18 – 25). This process can be done during the checkout process or from the portable terminal itself (Column 4 Lines 36 – 39). After all necessary corrections are made, the final transaction concerning payment methods can be made via a transaction on a central processing system (Column 6 Lines 34 – 47).

### ***Response to Arguments***

14. Applicant's arguments filed 4/13/07 have been fully considered but they are not persuasive.

### **Arguments under 35 USC § 102**

15. Applicants argue that Murrah fails to teach or suggest specifically a portable terminal comprising: a tag reader for reading via radio waves commodity information written onto a wireless tag located on a sample commodity remote from a checkout area. Although Murrah's specification discloses a portable terminal for scanning barcode information, Murrah also discloses

“Although the system has been described in the context of bar coded indicia on articles, the present invention could also be implemented on systems employed other coding schemes. An example of such an alternative scheme is radio frequency identification tags (Column 7 Lines 63 – 67).”

Consequently, one skilled in the art would have known to include an RFID reader in the portable terminal, as disclosed by Murrah, in the event that RFID tags were to be implemented.



**Arguments made under 35 USC § 103**

16. Applicant argues that Murrah et al. fails to teach lending out a portable terminal to customers. However, the examiner has already stated that, "It would have been obvious to lend customers to use the portable terminals if enough portable terminals are provided and, of course, have them return the portable terminals when they have finished shopping (**Page 4 Office Action written on 5/3/06**)." Moreover, the method of lending store owned equipment to customers is old and well known. For example, it is old and well known that grocery stores lend out shopping carts to customers to use during their shopping experience. Applicant also claims that Murrah et al. teaches away from lending out portable terminals because of security reasons (Murrah et al. Col. 5 L. 20 – 27). However, the examiner finds no support of this. On the contrary, Murrah et al. discloses the following on Col. 5 L. 20 – 27:

"It is preferred that the roving attendant **27** be provided with a plurality of bags to bag the merchandise at the time the items are scanned. Each bag may be uniquely identified with pre-marked codes or adhesive stickers so as to add an additional level of security. The identification of the bags for the specific customer may also be recorded in the customer data file. This would provide secure transportation of selected items and also avoid the need to rehandle the items."

As it can be seen, Murrah et al. does not disclose that for security reasons the portable terminals should not be handed out to customers. Therefore, applicants' ascertainment that "...Murrah et al. appears to teach away from such a modification"

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(the modification regarding lending out portable terminals) is incorrect and only pertains to the merchandise purchased by the customer.

Although, Murrah only discloses a preferred embodiment where roving attendants use the portable terminal, Murrah also discloses the present invention may be applied to any number of other data collection systems having a *plurality of **potential users** collecting pre-coded items which need to be processed prior to exiting the facility.* The Examiner asserts that Murrah does indeed teach that customers (potential users) are also able to use the portable terminals in the same manner that the roving attendants do.

**Regarding amendments**

17. Regarding the amendments made toward the claims, the examiner has addressed the amendments in the above Office Action.

***Conclusion***

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure can be found in PTO-892 Notice of References Cited.

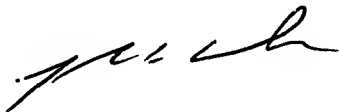
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerardo Araque Jr. whose telephone number is (571)272-3747. The examiner can normally be reached on Monday - Friday 8:30AM - 4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

GA  
5/4/07



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